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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,478	04/13/2001	Emily Chien	40655.1300	2560
66170	7590	06/24/2009		
Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 06/24/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/834,478	Applicant(s) CHIEN ET AL.	
	Examiner Dennis Ruhl	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/29/09 (6 of them); 3/24/09 (one); 03/09/09 (5 of them)</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/28/09 has been entered.

2. The amendment filed 2/27/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: All of the newly added subject matter that was added to the specification at page 25 is not supported by the originally filed specification. Applicant is referred to the 112,1st rejection where this is addressed in more detail as far as why the amendment to both the specification and the claims is considered to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

4. The specification is objected to under 37 CFR 1.71 because it fails to provide support as originally filed for the subject matter that has been added in the amendment of 2/27/09. The specification as originally filed never disclosed what is not added to the specification (as well as for what is newly claimed as is addressed under 112,1st).

Applicant is referred to the 112,1st rejection where this is addressed in more detail as far as why the amendment to both the specification and the claims is considered to be new matter.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1,3-42 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claims 1,5,19,23,24,33,37,38 by adding new subject matter that is not supported in the specification as originally filed. While not a 112,1st issue regarding the claims, the specification has been amended to disclose subject matter commensurate with the claim amendments that is also new matter.

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Applicant also added new claim 42 that recites subject matter that is not supported in the specification as originally filed. It was not reasonably clear upon a reading of the specification as originally filed that the inventors contemplated the invention as it is currently is claimed in claims 1,5,19,23,24,33,37,38, and 42, or that disclosed in the amended specification (not 112,1st issue but discussed here for purposes of brevity). Applicant has taken the position that the specification "incorporated by reference" application number 09/652,899 and 09/241,188, and that because of this incorporation, the newly added subject matter is not new matter. In the specification on page 15 it was stated:

"This system may be integrated with other systems to better facilitate the spending of loyalty points and the conversion of loyalty points to a currency credit. For more information on loyalty systems, smart card systems, transaction systems, electronic commerce systems and digital wallet systems, see, for example, the Shop AMEX™ system as disclosed in Serial No. 60/230,190 filed September 5, 2000; a digital wallet system disclosed in U.S. Serial No. 09/652,899 filed August 31, 2000; a stored value card as disclosed in serial number 09/241,188 filed on February 1, 1999; a system for facilitating transactions using secondary transaction numbers disclosed in Serial No. 09/800,461 filed on March 7, 2001, and smart card systems disclosed in Serial No. 60/232,040, filed on September 12, 2000, and U.S. Patent Nos. 5,742,845; 5,898,838 and 5,905,908, owned by Datascape, all of which are herein incorporated by reference."

With respect to the use of incorporation by particular attention is to be paid to the specific portions of the incorporated document(s) where the incorporated subject matter can be found. In this case, when determining from the specification as originally filed what the inventors contemplated as their invention, it is noted that there is no actual discussion regarding any of the incorporated references as to what is actually being

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incorporated as far as subject matter goes from each reference. There is no identification of where in the documents any incorporated subject matter can be found. In this case, applicant simply made a generic statement that "This system" may be integrated with other systems to better facilitate the spending of loyalty points and the conversion of loyalty points to a currency credit. Then it was stated that "For more information on loyalty systems, smart cards, transaction systems, electronic commerce systems and digital wallet systems, see..." and then a number of references are incorporated by reference. Applicant did not state what the subject matter actually was that was being incorporated from any of the references. The language of "*This system may be integrated with other systems to better facilitate the spending of loyalty points and the conversion of loyalty points to a currency credit*" is extremely vague and non-specific as far as what the subject matter was or what the integration was the inventors actually contemplated as their invention. In this case, how would one reading the specification reasonably know that the invention actually was a combination of only a portion of 09/652,899 and a portion of 09/241,188 along with the originally filed instant specification, and not portions of the other references as well. No guidance is given at all as to where in the references the incorporated subject matter can be found. Applicant's incorporation by reference is seen as nothing more than a vague and general reference to other references, with no particular attention paid to actually what it was that the inventors contemplated as their invention. Also, this disclosure does not seem to even reasonably provide support for taking one feature from one reference, taking another feature from another reference, and combining them with the originally

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filed disclosure for this application to arrive at the current claims. The instant examiner had no idea that the applicant felt that this was their invention, especially at such a late stage in the prosecution history. In the manner that applicant has attempted to incorporate by reference the various references on page 15, there could be an almost infinite number of possible combinations that applicant could potentially claim was their invention by simply picking and choosing various combinations from any of the references. This does not seem to be commensurate with the idea that an incorporation by reference has to actually identify the subject matter being incorporated and is to pay particular attention explaining where in the incorporated documents the incorporated subject matter may be found. The newly added subject matter added to claims 1,5,19,23,24,33,37,38, and 42 was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1,3-42 contain new matter and are not supported by the specification as originally filed.

7. Applicant's arguments filed 4/29/09 have been fully considered but they are not persuasive.

Applicant has argued that the newly added subject matter to the claims and the specification does not constitute new matter. The examiner disagrees for the reasons set forth in the 112,1st rejection of record. The rejection itself is seen as rebutting applicant's arguments and was drafted with applicant's arguments in mind.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689